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AD

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re The Biltmore Company a/k/a Biltmore Estate

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Serial No. 75/708,354

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Steven C. Schnedler of Carter & Schnedler, P.A. for The  
Biltmore Company a/k/a Biltmore Estate.

John T. Lincoski, Jr., Trademark Examining Attorney, Law  
Office 104 (Sidney Moskowitz, Managing Attorney).

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Before Walters, Bottorff and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 18, 1999, The Biltmore Company a/k/a Biltmore  
Estate (applicant) filed an application under the intent to  
use provision of the Trademark Act to register on the  
Principal Register the mark INN ON BILTMORE ESTATE (in  
typed form) for services identified as "hotel services" in  
International Class 42. Applicant has disclaimed the word  
"inn."

The Examining Attorney has refused to register  
applicant's mark under Section 2(d) of the Trademark Act,

15 U.S.C. § 1052(d), because of the registration of the mark FOUR SEASONS BILTMORE (in typed form) for "resort innkeeping services" in International Class 42.<sup>1</sup> The registration contains a disclaimer of the word "Biltmore."

The Examining Attorney also refused to register applicant's mark under Section 2(d) because of a second registration. That registration is for the mark THE BILTMORE LOS ANGELES and design shown below for "hotel services" in International Class 42.<sup>2</sup> The registration contains a disclaimer of the words "Los Angeles."



After the Examining Attorney made the refusals final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

We reverse both refusals under § 2(d).

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<sup>1</sup> Registration No. 1,857,988 issued October 11, 1994. Section 8 and 15 affidavits have been accepted and acknowledged, respectively. Office records indicate that the current owner is Four Seasons Hotels Limited.

<sup>2</sup> Registration No. 1,523,939 issued February 7, 1989. A Section 8 affidavit has been accepted. The registration indicates that the lining in the drawing is a feature of the mark. Office records indicate that the current owner is T.A.T. Los Angeles Co. Limited.

The Examining Attorney asserts that "at its heart, this case turns on the use of the word "BILTMORE." The term appears in both applicant's mark and the registrants' mark[s]." Examining Attorney's Br. at 3. The Examining Attorney maintains that BILTMORE is the dominant feature of the mark and that it has far more significance than the word ESTATE. The Examining Attorney also asserts that the services of the applicant and the registrants are similar and that "consumers would mistakenly believe that the services of applicant and the registrants emanated from a common source." Examining Attorney's Br. at 11.

Applicant submits that its predecessor is the originator of the name "Biltmore," and it submitted advertising for its hotel prior to its opening that describes its services as follows:

Announcing the Inn on Biltmore Estate

A deluxe hotel opening in Summer 2000, offering guests the luxury and turn-of-the-century graciousness befitting accommodations on Biltmore Estate. The Inn, located on a hill above the Winery, will provide striking vistas of the surrounding mountains and the roofline of Biltmore House.

In addition, applicant has submitted some evidence that others besides the two registrants use the term Biltmore in the names of hotels. Finally, applicant argues

that, because the marks create different commercial impressions, the refusals to register should be reversed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start by noting that applicant's services and the services in THE BILTMORE LOS ANGELES and design registration are both identified as "hotel services" and for purposes of our determination, they are identical. We agree with the Examining Attorney that the services in the FOUR SEASONS BILTMORE registration, identified as "resort innkeeping services," are similar to applicant's "hotel services."

The next question is whether applicant's and registrants' marks are similar in sound, appearance, or meaning such that they create similar overall commercial impressions. While applicant's mark and the two cited

registrations contain the same word "Biltmore," they have no other similarities. "When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared." Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ 1471, 1473 (Fed. Cir. 1992). However, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, we cannot say that "Biltmore" is such a dominant term that its use in marks with other significant features would nonetheless lead to a likelihood of confusion. It should be noted that the marks that are cited against applicant were previously involved in a case in which the Office refused to register the mark FOUR SEASONS BILTMORE because of the registration of the mark THE BILTMORE LOS ANGELES and design. Ultimately, the Federal Circuit reversed the Office's refusal to register because there was no likelihood of confusion. In re Four Seasons Hotels Ltd., 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993). While that case contained a consent agreement,

the Court noted that, as in this case, "there is no doubt that the marks FOUR SEASONS BILTMORE and THE BILTMORE LOS ANGELES share a common element. However, that purchasers will be confused by this commonality is not a necessary conclusion." Id. at 1072.

We are also cognizant of the requirement not to ignore elements in marks in order to find that there is a likelihood of confusion. In re Hearst Corp., 982 F.2d 493, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) ("The Board analyzing the marks for confusing similarity, found that 'varga' was the dominant element of the VARGA GIRL mark, and that 'girl' was merely descriptive and thus could not be afforded substantial weight in comparing VARGA GIRL with VARGAS. The Board erred in its analytic approach"); In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) ("We conclude that the TTAB erred in its dominant focus on the K+ in both marks, to the substantial exclusion of the other elements of both marks").

In this case, applicant's mark includes the words "inn on" and "estate;" one registration includes the words "Four Seasons;" and the second registration includes the words "the" and "Los Angeles" as well as a design. Not only are the additional words in the marks not identical, they have

no discernable similarities with each other. Applicant's mark refers to an inn on an estate, one registration apparently contains a house mark referring to the seasons, and the other registration contains a design with words identifying a specific city location. Apart from the word, "Biltmore," the marks have no similarities.

In addition, we emphasize that the Examining Attorney has cited two registrations owned by different parties and has held that applicant's mark is confusingly similar to both. This is not a case in which a party has submitted evidence of third-party registrations to support its argument that there is no confusion between its application and a cited registration. In re J.M. Originals, 6 USPQ2d 1393, 1394 (TTAB 1988) (Third-party registrations "cannot be used to justify the registration of another confusingly similar registration"). Here, the Federal Circuit has already determined that "there is no likelihood of confusion" between the marks FOUR SEASONS BILTMORE and THE BILTMORE LOS ANGELES and design. Four Seasons Hotel, 26 USPQ2d at 1073.

In these somewhat unusual circumstances, we are guided by the CCPA's decision in Swedish Beer Export Co. v. Canada Dry Corp., 469 F.2d 1069, 176 USPQ 59 (CCPA 1972). In that case, a party opposed the registration of an applicant's

mark SKOLA for soft drink based on its ownership of the marks SKOL and SKAL for beer. However, opposer's marks were initially refused registration because of a prior registration for the mark SKOL for vodka. After a consent agreement was submitted, the examiner passed opposer's mark to publication and eventually registration. When the owner of the SKOL beer registrations opposed the application, the CCPA concluded that there was no likelihood of confusion.

Relying on the consent agreement, the CCPA held that:

Clearly, there is at least as great a likelihood of confusion between SKOL for vodka and SKOL for beer as would exist between SKOL for beer and SKOLA for a soft drink. In the absence of confusion in the former case where the goods are both alcoholic beverages and the marks nearly identical, we are loathe to find a likelihood of confusion in the latter where the marks are different and one beverage is nonalcoholic.

Id. at 60.

Even more importantly, we not only have a consent agreement between the registrants in the present case, but also a determination by the Federal Circuit that these two registrations are not confusingly similar. Inasmuch as applicant's mark is significantly different in sound, appearance, and meaning from either cited registration, and those cited registrations can co-exist without a likelihood of confusion, we agree with applicant that there is no likelihood of confusion.



While it is not critical to our decision, we note that applicant submits that other hotels use the word "Biltmore" in their names. The Examining Attorney, on the other hand, argues that "Biltmore" is an "arbitrary, coined term." Examining Attorney's Br. at 6. We cannot agree that the term "Biltmore" is an arbitrary or coined term for hotel services. The record supports the conclusion that Biltmore is the name of an estate in Asheville, North Carolina. When the term would be used in association with lodging, it would have a suggestive connotation. In addition, the evidence in the file indicates that the term is not unique when applied to hotel services.

When we consider the marks in their entireties and the specific facts of this case, we conclude that there is no likelihood of confusion.

Decision: The refusals to register are reversed.